

Atty Dkt No. 6125-0001
PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
John P. CUMINGS et al.

Serial No.: 09/915,196

Filing Date: July 24, 2001

Title: TELESCOPED MULTIWALL NANOTUBE AND MANUFACTURE THEREOF

Confirmation No.: 5292

Group Art Unit: 1773

Examiner: Hoa T. LE

RECEIVED
AUG 21 2003
TC 1700

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Restriction mailed July 16, 2003, in which the Examiner required restriction between two groups of claims:

- (I) claims 1-17, directed to a method of making multiwall nanotube; and
- (II) claims 18-32, directed to a nanotube.

In response, applicants elect Group I, claims 1-17, without traverse. Applicants expressly reserve their right under 35 USC § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application.

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, the Examiner is welcome to contact the undersigned attorney at (650) 330-0900.

Respectfully submitted,

By:

Louis L. Wu
Registration No. 44,413

REED & EBERLE LLP
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Menlo Park, California 94025
(650) 330-0900 Telephone
(650) 330-0980 Facsimile

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| | | |
|---|------------------------|-----------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) AUG 20 2003 PATENT & TRADEMARK OFFICE | Application Number | 09/915,196 |
| | Filing Date | July 24, 2001 |
| | First Named Inventor | John P. CUMINGS |
| | Art Unit | 1773 |
| | Examiner Name | Hoa T. LE |
| | Attorney Docket Number | 6125-0001 |

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ENCLOSURES (Check all that apply)

- | | | |
|--|--|---|
| <input checked="" type="checkbox"/> No fee due <input checked="" type="checkbox"/> Fee Transmittal <input type="checkbox"/> Fee(s) due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Check for \$0 <input checked="" type="checkbox"/> Charge any underpayment or credit any overpayment to Deposit Account No. 18-0580 <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement & Form(s) PTO-1449 <input type="checkbox"/> Copy(ies) of cited reference(s) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s): | <input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Response to Requirement for Restriction and Return Postcard. |
| Remarks: | | |

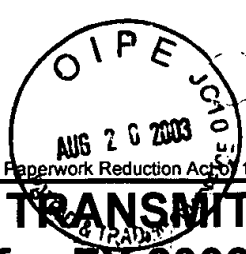
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | | | |
|-------------------|-----------------|-----------------------------------|--------|-----------|-----------------|
| Name (print/type) | Louis L. Wu | Registration No. (Attorney/Agent) | 44,413 | Telephone | (650) 330-0900 |
| Signature | <i>L. L. Wu</i> | | | Date | August 18, 2003 |

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 18, 2003.

| | | | |
|-------------------|-----------------------------|------|-----------------|
| Name (print/type) | Margaret K. Surridge | Date | August 18, 2003 |
| Signature | <i>Margaret K. Surridge</i> | | |



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**FEE TRANSMITTAL
for FY 2003**

Effective 01/01/03. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** \$0**Complete if Known**

Application Number 09/915,196

Filing Date July 24, 2001

First Named Inventor John P. CUMINGS

Examiner Name Hoa T. LE

Group Art Unit 1773

Attorney Docket No. 6125-0001

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☒ None☐ Deposit Account:

Deposit Account No.

Deposit Account Name

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge any underpayment or credit any overpayments☐ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 750 | 2001 | 375 | Utility filing fee | 0 |
| 1002 | 330 | 2002 | 165 | Design filing fee | |
| 1003 | 520 | 2003 | 260 | Plant filing fee | |
| 1004 | 750 | 2004 | 375 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) \$0**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------|--------------|----------------|----------|
| 32 | 0 | 0 | 0 |
| 2 | 0 | 0 | 0 |
| | | 0 | 0 |

| Large Entity | | Small Entity | | Fee Description |
|--------------|----------|--------------|----------|--|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1202 | 18 | 2202 | 9 | Claim in excess of 20 |
| 1201 | 84 | 2201 | 42 | Independent claims in excess of 3 |
| 1203 | 280 | 2203 | 140 | Multiple dependent claim, if not paid |
| 1204 | 84 | 2204 | 42 | ** Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) \$0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 410 | 2252 | 205 | Extension for reply within second month | |
| 1253 | 930 | 2253 | 465 | Extension for reply within third month | |
| 1254 | 1,450 | 2254 | 725 | Extension for reply within fourth month | |
| 1255 | 1,970 | 2255 | 985 | Extension for reply within fifth month | |
| 1401 | 320 | 2401 | 160 | Notice of Appeal | |
| 1402 | 320 | 2402 | 160 | Filing a brief in support of an appeal | |
| 1403 | 280 | 2403 | 140 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,300 | 2453 | 650 | Petition to revive - unintentional | |
| 1501 | 1,300 | 2501 | 650 | Utility issue fee (or reissue) | |
| 1502 | 470 | 2502 | 235 | Design issue fee | |
| 1503 | 630 | 2503 | 315 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 750 | 2809 | 375 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 1810 | 750 | 2810 | 375 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 1801 | 750 | 2801 | 375 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

\$0

SUBMITTED BY

Name (Print/Type) Louis L. Wu

Registration No. (Attorney/Agent) 44,413

Telephone

Complete (if applicable)

(650) 330-0900

Signature

Date

August 18, 2003